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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,835	04/26/2005	Paul Wallace	09931-00039-US	8863
23416	7590	07/06/2007	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			SHIAO, REI TSANG	
P O BOX 2207			ART UNIT	PAPER NUMBER
WILMINGTON, DE 19899			1626	
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07/06/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/532,835	WALLACE ET AL.	
Examiner	<b>Art Unit</b>		
Rei-tsang Shiao, Ph.D.	1626		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 06 June 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-23, 25 and 26 is/are pending in the application.  
4a) Of the above claim(s) 16-23 and 25 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 and 26 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_.  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/11/05, 06/27/05, 4/26/05.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

**DETAILED ACTION**

1. This application claims benefit of the foreign application:

EUROPEAN PATENT OFFICE (EPO) 02024183.2 with a filing date 10/30/2002.

2. Claims 1-23 and 25-26 are pending in the application.

***Information Disclosure Statement***

3. Applicant's Information Disclosure Statements, filed on July 11, 2005, June 27, 2005 and April 26, 2005 have been considered. Please refer to Applicant's copies of the 1449's submitted herein.

***Responses to Election/Restriction***

4. Applicant's election with traverse of election of Group I claims 1-15 and 26, in part, in the reply filed on June 06, 2007 is acknowledged. Election of a single disclosed species, 9-phenyl-9'-(tert-butylphenyl)-2,7-dibromofluorene, is also acknowledged. The traversal is on the grounds that a search and examination of the entire application would not place a serious burden on the Examiner, and MPEP §803 is cited.

This is found persuasive, in part, and the reasons are given *infra*.

Claims 1-23 and 25-26 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1-15 and 26 are drawn to processes of making compounds of formula (IV).

The claims 1-23 and 25-26 herein lack unity of invention under PCT rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art, see Spreitzer et al. US 6,653,438. Spreitzer et al. disclose similar phenyl compounds as the instant invention. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Furthermore, even if unity of invention under 37 CFR 1.475(a) is not lacking, which it is lacking, under 37 CFR 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product', or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

And, according to 37 CFR 1.475(c)

if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

However, it is noted that unity of invention is considered lacking under 37 CFR 1.475(a) and (b). Therefore, since the claims are drawn to more than a product, and according to 37 CFR 1.475 (e)

the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

The claims lack unity of invention and should be limited to only a product, or a process for the preparation, or a use of the said product. In the instant case, Groups I-V are drawn to various processes, various products (i.e., formula (IV), (V) or (VI)), and the final products do not contain a common technical feature or structure, and do not define a contribution over the prior art, i.e., similar phenyl compounds. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner. Claims 1-15 and 26 are prosecuted in the case. Claims 16-23 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 and 26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, page 4, line 1, recites the limitation "L is a liking group of 1-2 atom", is ambiguous and indefinite. It is unclear what "L is a liking group of 1-2 atom" is. Is it an

alkyl group or alkyl group having a heteroatom? Clarification is required. Dependent claims 2-15 and 26 are also rejected along with claim 1 under 35 U.S.C. 112, second paragraph.

***Claim Objections***

6. Claim 1 is objected to as containing a typographic error "ofoptionally", see page 4, line 2: Replacement of the term "ofoptionally" with the term "of optionally" would obviate the objection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rei-tsang Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

July 03, 2007